

The opinion in support of the decision being entered today was not written for Publication and is not binding precedent of the Board

Paper No. 22

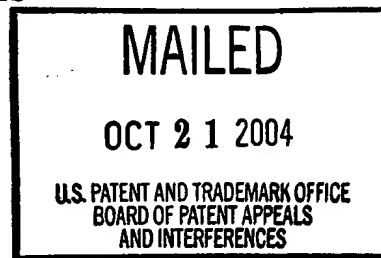
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VIKTORS BERSTIS

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Appeal No. 2004-0014  
Application No. 09/404,398

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ON BRIEF



Before KRASS, SMITH, JERRY and RUGGIERO, Administrative Patent Judges.

SMITH, JERRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-24. The examiner failed to recognize that claims 5 and 21 had been cancelled in an amendment filed July 9, 2002.

The disclosed invention pertains to a method and apparatus for providing a location of products to a customer in a retail environment.

Representative claim 1 is reproduced as follows:

1. A method for providing a location of products to a customer in a retail environment, said method comprising the steps of:

attaching a product locator unit to a shopping aid that is utilized within said retail environment, said product locator unit having an access point for entering a customer ID, a storage location for electronically storing a list of customer desired products, an infra red (IR) receiver that receives IR signals with localized product information at specific locations in which said IR signal is broadcasted, a program algorithm for comparing said localized product information with product identifiers (IDs) of said customer desired products, and, a signaling mechanism for alerting said customer to a location of a desired product, said location being identified by said received IR signal; and

enabling in-shopping signaling to said customer of the presence of a desired product when said customer is in the vicinity of said desired product, wherein said signaling is completed responsive to a (1) receipt of an IR signal at a particular location by the IR receiver of the product locator unit, and (2) correct matching of the ID of said desired product with said localized product information within said IR signal received.

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The examiner relies on the following references:

Ogasawara	6,123,259	Sep. 26, 2000 (filed Apr. 30, 1998)
Jelen et al. (Jelen)	6,129,276	Oct. 10, 2000 (filed July 30, 1999)

Claims 1-4, 6-20 and 22-24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Ogasawara in view of Jelen.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

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in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying

with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made, but chose not to make in the brief, have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

Appellant has indicated that independent claims 1, 8 and 15 stand or fall together as a single group [brief, page 4], and we will consider claim 1 as the representative claim for this group. With respect to claim 1, the examiner essentially finds that Ogasawara teaches the claimed invention except that Ogasawara uses radio waves instead of infrared signaling. The examiner cites Jelen as teaching the use of infrared signaling in

an electronic shopping system. The examiner finds that it would have been obvious to the artisan to use Jelen's infrared signaling in the shopping system of Ogasawara [answer, pages 3-4].

Appellant argues that Ogasawara does not teach or suggest an infrared receiver that receives IR signals with localized product information and a signaling mechanism for alerting the customer to the presence of a desired product identified by the received IR signal. Appellant also argues that the examiner has mischaracterized the teachings of Ogasawara and that Jelen does not overcome the deficiencies of Ogasawara.

The examiner responds by pointing to several portions of Ogasawara and Jelen and by asserting that "the combination of Ogasawara and Jelen discloses all the features present in the Applicant's claims" [answer, pages 9-12].

Appellant responds that the functionality of the claimed invention is very different from the functionality of the applied prior art [reply brief].

We will not sustain the examiner's rejection of independent claims 1, 8 and 15 because the examiner has failed to establish a prima facie case of obviousness. The examiner has

reduced appellant's invention to a concept and has found the concept in the prior art. Specifically, the examiner has considered the invention to be nothing more than guiding a customer from one location in a store to another location within the store. The examiner has failed, however, to consider the specific language of the claims. Claim 1 recites that the IR signal carries localized product information which is received by a product locator unit that signals the customer that a product the customer seeks to buy is within the area of the receiver.

That is, the IR transmitter is not transmitting location information, but instead, the transmitter is transmitting product information. In Ogasawara, the customer does not receive any product information from a transmitter although the customer can send product information in order to provide the location of the customer. Since there is no transmission of product information to the customer in Ogasawara, there is also no signaling to the customer to alert the customer that the customer is in the area of a product desired. Jelen does not overcome the deficiencies of Ogasawara. Regardless of whether Ogasawara uses radio waves or infrared signaling, the signals received by the customer in Ogasawara do not contain localized product information which is

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matched to products desired by the customer in order to signal  
the customer that he is in the vicinity of a desired product.

Since we have not sustained the examiner's rejection of  
independent claims 1, 8 and 15, we also do not sustain the  
examiner's rejection of the claims which depend therefrom.  
Although independent claim 24 is argued separately by appellant,  
claim 24 also contains limitations similar to the limitations of  
claims 1, 8 and 15. Therefore, we do not sustain the examiner's  
rejection of claim 24 for the same reasons discussed above with  
respect to claim 1.



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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 6-20 and 22-24 is reversed.

REVERSED

  
ERROL A. KRASS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

## INTERFERENCES

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